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10/567,259

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Shigeo Yukawa

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HAMRE, SCHUMANN, MUELLER & LARSON, P.C.

P.O. BOX 2902

MINNEAPOLIS, MN 55402-0902

EXAMINER

DOAK, JENNIFER L

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/567,259	<b>Applicant(s)</b> YUKAWA ET AL.	
	<b>Examiner</b> Jennifer L. Doak	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18 and 20-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (US 4505967) and Hedblom ((US 6479132).

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Regarding claims 1 and 22, Bailey discloses an enclosed lens type retroreflective sheet (Fig. 3) comprising a surface layer (10a) including at least one layer, a focusing layer (19c) containing glass spheres (27), and a metal reflective layer (28) on the back side of the focusing layer (Fig. 3), the metal reflective layer is formed on the back side of the focusing layer to follow the shape of the glass spheres (Fig. 3), and the glass spheres (col. 10, lns. 39-44) include a first glass sphere group that provides reflective performance at a small observation angle of  $2^\circ$  or less (col. 7, ln. 39 at  $-4^\circ$ ; as illustrated in Fig. 7, Curve A, between approx.  $0^\circ$  and  $20^\circ$ ) and up to a large incidence angle of from  $5^\circ$  to less than  $90^\circ$  (col. 7, ln. 13 at  $5^\circ$ ) and a second glass sphere group that provides reflective performance at an observation angle greater than  $2^\circ$  (col. 7, ln. 39 at  $-4^\circ$ ) and up to a large incidence angle of from  $5^\circ$  to less than  $90^\circ$  (col. 7, ln. 13 at  $5^\circ$ ; as illustrated in Fig. 7, Curve A, between approx.  $20^\circ$  and  $50^\circ$ ) in the same focusing layer (Fig. 3). Further, Bailey discloses that the surface layer is present at positions (i.e., no special definition of "positions" is found in the specification) over the first and second glass sphere groups (Fig. 3: 10a, since 10a, the surface layer, is over the glass spheres).

Bailey does not disclose that the glass spheres are disposed at random locations in the thickness direction of the focusing layer or that the focusing layer for the second glass sphere group is thinner at the glass spheres than a focus formation position for the glass spheres. Bailey and Hedblom are related as retro-reflector bead systems, and would have been known to an ordinarily skilled artisan at the time of invention. Hedblom teaches that the glass spheres are disposed at random locations (col. 10, lns. 38-41) in the thickness direction of the focusing layer and that the focusing layer for the second glass sphere group is thinner at the glass spheres than a focus formation position for the glass spheres (Fig. 4; col. 3, lns. 40-44).

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Examiner additionally finds that the device of Bailey constitutes a base device upon which the claimed invention can be seen as an improvement. Bailey and Hedblom are comparable devices, since both are retroreflector systems with beads, focusing layers backed with shape-fitted reflective layers. Additional layers are optional, but contemplated by Hedblom (col. 2, lns. 65-67). As set forth above, the comparable device of Hedblom was improved the same way as the claimed device: random bead distribution and varied thickness of the focusing layer. The benefit of such an improvement is that there is quality reflection in both wet and dry conditions (Hedblom, col. 6, lns. 39-67). Moreover, Examiner finds that an ordinarily skilled artisan could have applied the known improvement in the same way to the base device, and the results would have been predictable to an ordinarily skilled artisan at the time of invention.

Therefore, pursuant to *In re Nilssen*, 7 USPQ2d 1673 (Fed. Cir. 1988) and *Ruiz v. AB Chance Co.*, 69 USPQ2d 1686 (Fed Cir. 2004), that it would have been obvious to an ordinarily skilled artisan at the time of invention to modify the retroreflective sheet of Bailey with the randomness of the beads and variable focus layer thicknesses of Hedblom, since such a combination would yield predictable results to an ordinarily skilled artisan of the time.

Further regarding claim 22, the elements addressed previously in the discussion of claim 1 are hereby incorporated, and the combination discloses the following additional elements: a sign having a sign face (Bailey, col. 1, lns. 53-60), an external illumination source, where the external illumination source is disposed at a fixed distance from the illumination source to the sign face is within a range of at least 1 m and no more than 100 m (i.e., it is well known in the art that a truck with a sign on it, as contemplated above by Bailey, if driving along a highway or street at night would likely pass many fixed illumination sources within the range of 1 m to 100

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m of the sign on the side of the truck as it drove past street lamps. Moreover, it is noted that the flux, that is the luminous intensity of light, decreases from its source in the proportion of  $1/r^2$ , where  $r$  is the distance from the source; therefore, the diminished capacity of a fixed position light would render it weak to useless at larger distances such as 100 m.). The purpose of fixed roadside lighting is to illuminate stationary and moving objects, including other vehicles, for the safety of drivers along the road. Lighting must be placed at an appropriate distance from the object or area to illuminate relative to its flux capacity to be effective.

Therefore, it would have been obvious to an ordinarily skilled artisan at the time of invention to use a fixed light to illuminate a sign face at a range of 1 m to 100 m, since sufficient illumination is necessary to use it as a safety feature of the road.

Regarding claim 2, the combination further discloses that the first glass sphere group comprises spheres in contact with the surface layer (Bailey, Fig. 3), and the second glass sphere group comprises spheres located away from the surface layer (this is true via the teaching of the combination that the spheres can be randomly distributed in the focusing layer direction; Hedblom, col. 10, lns. 38-41).

Regarding claim 3, the combination further discloses that the metal reflective layer of the first glass sphere group is formed at the focus formation position of the glass spheres (Bailey, col. 1, lns. 20-26).

Regarding claim 4, the combination further discloses that the focusing layer formed in the form of concentric circles on the glass sphere surfaces of the glass spheres in contact with the surface layer has a thickness at which the maximum reflective performance is exhibited at an observation angle of  $0.2^\circ$  and an incidence angle of  $5^\circ$  (Bailey, Fig. 7: Curve B, in that there is a

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local maximum within the claimed range as well as another, approximately equal maximum later in the same curve between 20° and 50°), the thickness of the focusing layer of the glass spheres located away from the surface is less than the thickness of the focusing layer of the glass spheres in contact with the surface layer (i.e., this limitation is seen to be met by the combination since the spheres have different thicknesses of the focusing layer and are randomly dispersed), and the glass spheres located away from the surface layer exhibit retroreflective performance at a relatively larger observation angle than the glass spheres in contact with the surface layer (i.e., this limitation is seen to be met by the combination since the spheres have different thicknesses of the focusing layer and are randomly dispersed).

Regarding claim 5, the combination does not proportion of glass spheres in contact with the surface layer is from 50 to 90 weight percent of the total glass spheres. However, this limitation is inherent to the structure previously recited, and the claim language is necessarily met by that structure. Absent a showing to the contrary, the features recited above would be met by the structure of the combined teachings of the prior art or would be met during use of the same.

Regarding claim 6, the combination further discloses the refractive index of the glass spheres is within a range of at least 2.10 and no more than 2.40 (Hedblom, col. 4, lns. 63-67).

Regarding claim 7, the combination further discloses the glass spheres have a median diameter within a range of at least 35  $\mu\text{m}$  and no more than 75  $\mu\text{m}$  (Bailey, col. 4, lns. 37-41), and at least 80% of the glass spheres have a median diameter within a range of  $\pm 10$   $\mu\text{m}$  (col. 4, lns. 37-41).

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Regarding Claims 8-18, the combination further discloses that specific chemicals can be used, including polyvinyl acetal resin, polyvinyl butyral resin, olefin copolymers, polyester resins, alkyd resins, polyurethane resins, vinyl resins, and acrylic polymers (Hedblom, col. 7, lines 18-33; col. 9, lines 10-37; col. 10, lines 1-19). The weight relationships, transition point temperatures, solvent relationships, and related anti-foaming agents are not explicitly disclosed, but are well known in the art. Therefore, absent a showing of criticality, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the chemicals and the claimed relations, since they result in retro-reflectors that remain retro-reflective in wet or dry conditions.

Regarding claims 20 and 21, the combination further discloses the illumination source emits light that is incident on the sign face at an incidence angle of between at least  $0^{\circ}$  and  $50^{\circ}$  to the sign face (Bailey, Fig. 7); that the sign face exhibits reflective performance of at least 0.07 at an observation angle of  $35^{\circ}$  when reference light (Bailey, Fig. 7); that the reflective performance at an observation angle of  $40^{\circ}$  and an incidence angle of  $50^{\circ}$  is at least 0.055, and so forth as set forward in the remainder of claims 20 and 21). The combination does not disclose that the angle cannot be more than  $50^{\circ}$  or that the color temperature of the light is 2856K. The wavelength, whose color temperature is 2856K, is a well known marker line for mercury vapor emissions. Mercury lamps are notoriously well known in the art for outdoor light sources, for signs or for general illumination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a mercury lamp to illuminate a sign.

The combination does not explicitly disclose that the retroreflective coefficient  $R' = I/ES \cdot A$ ; However, this feature is seen to be an inherent teaching of that device since the structure



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as claimed is disclosed, and it is apparent that the same structure must be present for the device to function as intended.

### ***Response to Arguments***

Applicant's arguments filed 9/15/09 have been fully considered but they are not persuasive.

Applicant argues (1) the purpose of Bailey is to have even layering and there is no reason to have multiple groups and/or any reason for combination (REMARKS, p. 8); (2) two groups are not taught, and the distance to the top layer is irrelevant (p. 8); (3) performance of exposed lenses in Hedblom do not make a reasonable motivation for combination (p. 9); (4) the reference stating that "skid-resistant particles are randomly sprinkled" has nothing to do with the location of the glass spheres (p.10).

Examiner respectfully disagrees. (1) The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). (2) Two groups are taught: (i) those closest to the surface, (ii) those farthest from the surface; thus, thickness of the top layer is critical to Examiner's interpretation. (3) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347,

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21 USPQ2d 1941 (Fed. Cir. 1992). In this case, predictability is also cited pursuant to *In re Nilssen*, 7 USPQ2d 1673 (Fed. Cir. 1988) and *Ruiz v. AB Chance Co.*, 69 USPQ2d 1686 (Fed. Cir. 2004).

With respect to argument (4), Applicant's assertion mistakenly emphasizes the "skid-resistant particles" rather than the randomness of their sprinkling, for which it was cited. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer L. Doak whose telephone number is (571)272-9791. The examiner can normally be reached on Mon-Thurs: 7:30A-5:00P, Alt Fri: 7:30A-4:00P (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. L. D./  
Examiner, Art Unit 2872

/Alessandro Amari/  
Primary Examiner, Art Unit 2872